

## REMARKS

By this amendment, claims 1-9 have been canceled and claims 14 and 16 have been amended. Claims 10-16 remain in the application. Support for the amendments to the claims can be found the specification and drawings. No new matter has been added. Reconsideration, and allowance of the application, as amended, is respectfully requested.

### Election/Restrictions

In the office action mailed January 27, 2009, the Examiner required restriction between Claims 1-5 (Group I), drawn to a process of making a mold, Claims 6-8 (Group II), drawn to a process of making contact lenses, and Claims 10-16 (Group III), drawn to an apparatus for making a mold.

Responsive thereto, Applicants elect to prosecute the claims of Group III, without traverse and without prejudice to, inter alia, Applicant's right to pursue the canceled claims in a divisional application.

### Objection to the Claims

Claim 14 was objected to because of informalities. Applicant acknowledges the objection to claim 14 and in response has amended the same to depend from claim 11 and thus provide antecedent basis for the "optical projection system." Withdrawal of the objection to claim 14 is respectfully requested.

### Rejection under 35 U.S.C. §103

Claim 16 recites a device for exposing, to a predetermined pattern of exposure radiation during a predetermined time, a photoresist layer on a mold surface of a mold having a base shape, the device comprising:

- a radiation source for emitting UV radiation,
- optical means for concentrating the emitted radiation into

an exposure beam,

a spatial light modulator configured to impart to the exposure beam a radiation distribution according to the predetermined pattern and render the photoresist layer developable to selectively remove photoresist material according to the radiation pattern and shape the exposed surface of the layer to a required end shape of the mold, and

a mold holder arranged in the path of the radiation from the spatial light modulator for holding the mold to be exposed,

wherein the base shape of the mold is configured to be modified to obtain the required end shape of the mold surface further in response to a hot flow development wherein (i) the mold with the exposed patterned photoresist layer is heated to a predetermined temperature to make unexposed photoresist of the exposed patterned photoresist layer fluid and (ii) fast spinning the mold to remove the fluid unexposed photoresist.

Support for the amendments to claim 16, can be found in the specification at least on page 3, lines 16-20; page 4, line 22; and FIG. 2, as originally filed.

Claims 16 and 10-12, 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Harchanko** (WO 2004/039554; herein referred to as **Harchanko**) further in view of **Jones** (US 4909818; herein referred to as **Jones**). With respect to claim 16, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 16.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie*

*case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The **Harchanko** and **Jones** references cannot be applied to reject claim 16 under 35 U.S.C. §103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...* (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Harchanko** nor **Jones** teaches an “optical means for concentrating the emitted radiation into an exposure beam ... and ... wherein the *base shape* of the mold is *configured to be modified* to obtain the *required end shape* of the mold surface further in response to a *hot flow development* wherein (i) the mold ... is *heated* to a predetermined temperature to *make* unexposed photoresist of the *exposed patterned photoresist layer fluid* and (ii) *fast spinning* the mold to *remove the fluid* unexposed photoresist” (emphasis added) as is claimed in claim 16, it is impossible to render the subject matter of claim 16 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie*

case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

In contrast, **Jones** discloses a beam profiler 14 which includes a negative cylindrical lens 15 to expand the output beam 13 ... to provide a profiled beam 17 (emphasis added) (see Jones, column 2, lines 40-44). Thus, **Jones** teaches a profiled beam 17, which is an *expansion* of beam 13, and thus teaches away from an optical means for “concentrating” emitted radiation.

## **2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case the **Jones** reference, by providing a beam profiler which includes a negative cylindrical lens is directed to a system in which the beam profiler expands the output beam to provide a profiled beam. Thus, this system clearly teaches away from claim 16, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## **3. The Combination of References is Improper**

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another

compelling reason why the **Harchanko** and **Jones** references cannot be applied to reject claim 16 under 35 U.S.C. §103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither **Harchanko** nor **Jones** teaches, or even suggests, the desirability of the combination since neither teaches the specific arrangement of "optical means for concentrating the emitted radiation into an exposure beam ... and ... wherein the base shape of the mold is configured to be modified to obtain the required end shape of the mold surface further in response to a hot flow development wherein (i) the mold ... is heated to a predetermined temperature to make unexposed photoresist of the exposed patterned photoresist layer fluid and (ii) fast spinning the mold to remove the fluid unexposed photoresist" (emphasis added) as specified above and as claimed in claim 16.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention,

absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination indicated in the Office Action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 16. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claims 10-12 and 14 depend from and further limit independent claim 16 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome.

Claims 13 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Harchanko** (WO 2004/039554; herein referred to as **Harchanko**) further in view of **Jones** (US 4909818; herein referred to as **Jones**), and further in view of **MacKinnon** (US 2002/0135763; herein referred to as **MacKinnon**). Applicant respectfully traverses this rejection for at least the following reason. Claims 13 and 15 depend from and further limit independent claim 16, in a patentable sense, and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

### Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claim 16 is in condition for allowance. Claims 10-15 depend from and further limit independent claim 16, and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 16 and 10-15 is requested.

Respectfully submitted,

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